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PATENT  
Docket No.: 02558B-059411US  
Client Ref. No.: BRP00091 (divisional)

On

*December 17, 2003*

TOWNSEND and TOWNSEND and CREW LLP

By:

*[Signature]*

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Michael I. Watkins and Richard B. Edwards

Application No.: 09/905,338

Filed: July 13, 2001

For: MULTIPLEX FLOW ASSAYS  
PREFERABLY WITH MAGNETIC  
PARTICLES AS SOLID PHASE

Examiner: Jeffrey J. Stucker

Art Unit: 1648

REQUEST FOR RECONSIDERATION

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated October 23, 2003, Applicants submit the comments below, together with the accompanying Declaration under 37 C.F.R. 1.131, and respectfully request reconsideration and reexamination of this Application.

The claims in this application are nos. 21-29 and 50-58. Claims 21-23, 26, 27, 29 and 54-58 stand rejected as anticipated by Walt et al. (U.S. patent 6,023,540); claims 21-29 and 50-58 stand rejected as obvious over Walt et al. in view of Coulter (GB 1,561,042).

Walt et al. is characterized as stating that microspheres are commercially available in a range of sizes that overlaps the claimed range with characteristics including sizes and surface chemistries, and that such microspheres may be paramagnetic.

Applicant submits, however, that these characterizations are overly broad in light of the actual disclosure of Walt et al., such that this reference does not anticipate the indicated claims, nor render the claims obvious in combination with Coulter.

Walt et al. disclose the use of plastic or ceramic beads and was submitted in this application because of its incidental and general disclosure that "beads comprising ... paramagnetic..." were also possibilities. There is, however no disclosure in Walt et al. that a composition such as that defined in claim 21 was commercially available, or even had been made by Walt et al. or anyone else. The statement in col. 5 (last paragraph) that "a large selection of such pre-prepared microspheres are currently available from a number of commercial vendors" does not render the present claims, which require a combination of certain types of magnetic beads, anticipated.

Walt et al. in addition, relates to a process in which their microspheres are coupled to discrete fibers in a bundle of optical fibers where the bundle acts as a sensor (col. 3). In such a process the microspheres are not suitable for use in a multiplex assay procedure that includes the use of flow cytometry.

In addition, the Declaration under 37 C.F.R. 1.131 submitted herewith, establishes that the Applicants made their invention prior to the March 14, 1997 filing date of Walt et al. This patent thus does not constitute prior art to Applicants.

CONCLUSION

In view of the foregoing, Applicants submit that the claims in this Application are in condition for allowance, and request an early Notice to the effect...

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned.

Respectfully submitted,

Joel G. Ackerman  
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